

TRADEMARK
Attorney Docket No. 20750-15US

Date of Deposit: November 19, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, Box RESPONSES NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3514.

By: 

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

APPLE COMPUTER, INC.¹

Serial No. 75/865,080

Filed: December 16, 1999

Mark: **IDVD**

Trademark Attorney: Michele-Lynn Swain

Law Office: 116

REQUEST FOR RECONSIDERATION

Commissioner for Trademarks
Box RESPONSES NO FEE
2900 Crystal Drive
Arlington, VA 22202-3514

Madam:

This responds to the final Office Action dated May 19, 2003. Apple Computer, Inc. ("Apple") asks the Examining Attorney reconsider the Office's refusal to register the previous owner's **IDVD** mark pursuant to Section 2(e) of the Trademark Act.²

¹ By assignment from Ravisent IP, Inc.

² Applicant has timely filed a Notice of Appeal and provides a courtesy copy with this Request for Reconsideration. (Exhibit 1).

AMENDMENT

Change in Ownership

Apple is the owner of the subject application by virtue of assignment from Ravisent IP, Inc. The assignment was recorded with the Assignment Division of the Patent and Trademark Office on November 18, 2003, at Reel 002748, Frame 0775. A copy of the recorded assignment is attached as Exhibit 2. Applicant requests the registration issue in the name of the new owner, Apple Computer, Inc.

Amendment to Amendment to Allege Use

Apple submits an amended Amendment to Allege Use, attached hereto as Exhibit 3, claiming use back to January 9, 2001, much earlier than the previous owner.

REMARKS

As Apple is now the owner of this application, the application to register the mark **IDVD** is now based upon Apple's use of the mark, in addition to that of the previous owner for the reason detailed below. Apple therefore requests that the Examining Attorney reconsider the application in light of these changed circumstances.

The **IDVD** mark, as a member of the well-known family of Apple "I" marks, is inherently distinctive in connection with Apple's goods. However, in the alternative, if the Examining Attorney determines that the **IDVD** mark is not inherently distinctive, Apple has provided ample evidence to demonstrate that the mark has acquired distinctiveness through Apple's extensive use of the **IDVD** mark in connection with its software goods.

I. APPLE'S IDVD MARK IS SUGGESTIVE AND THUS INHERENTLY DISTINCTIVE

The Examining Attorney has refused registration under Section 2(e), believing the proposed mark to be merely descriptive. Apple respectfully disagrees. The **IDVD** mark in its entirety identifies Apple as the source of the goods. Much of the Examining Attorney's evidence for descriptiveness shows that consumers and the general public recognize **IDVD** as an Apple Computer trademark — part of the well-known family of Apple "I"-formative marks — and not as a merely descriptive term. Apple requests that the Examining Attorney withdraw the refusal because Apple's **IDVD** mark is suggestive of Apple's goods.

A. The Office Has Not Met Its Burden Of Proof; There Is No Evidence That IDVD, Properly Viewed In Its Entirety, Is Merely Descriptive

It is the Office's initial burden to show that a mark is merely descriptive of the goods in the mind of the consumer. *In re Gyulay*, 3 U.S.P.Q. 2d 1009 (Fed. Cir. 1987). If registration is refused, the Examining Attorney must support the refusal with evidence. T.M.E.P. § 1209.02. It is, therefore, the Examining Attorney's burden to prove that the mark in its entirety has a well-understood and recognized meaning. T.M.E.P. § 1209.01(b)(2). *See also In re ILine LLC*, 2002 WL 1275659 (T.T.A.B. 2002) (reversing the descriptiveness refusal for **ILINE** for failure of the Examining Attorney to provide sufficient evidence support the contention that "I" was synonymous with "internet").

Here, the record lacks evidence that the **IDVD** mark in its entirety has meaning. Rather, supporting the May 19, 2003 Office Action, there are LEXIS excerpts that merely include the words "interactive" and "IDVD," the majority of which refer directly to Apple's use of **IDVD** as a mark for its software product. In the text of the Office Action, the Examining Attorney refers to two such references, both of which refer to Apple's **IDVD** product, as evidence of

descriptiveness of the mark. However, the **IDVD** mark is clearly used in both of these references as an indication of source for Apple's product and not as a descriptive reference to an "interactive digital versatile disc." The Examining Attorney's own efforts to find descriptive references to **IDVD** have resulted in one reference to an "IDVD player." This isolated reference is hardly sufficient evidence to show that the *primary* meaning in the mind of consumers of the **IDVD** is as a merely descriptive term referring to an "interactive digital versatile disc." On the other hand, an internet search reveals many tens of thousands references to Apple's use of the **IDVD** as a mark for its product. See Declaration of Marilyn J. Bowen ¶ 4 ("Bowen Decl."). Thus, there is insufficient evidence in the record to show that consumers will perceive of Apple's **IDVD** mark as merely describing its software. Indeed, the record remains that there is no evidence that the term "IDVD" is needed to describe goods and services related to those of Apple, apart from the use of the term as a source identifier of Apple's, and Apple's predecessor-in-interest's, **IDVD** products.

Because the Office has not met its initial burden of proof on mere descriptiveness, there is nothing for Apple to rebut. The descriptiveness refusal should be withdrawn, and the application advanced to publication.

B. IDVD Is Distinctive And Immediately Recognized by Consumers As A Source Identifier For Apple's Software Goods

Even if the Office were to meet its initial evidentiary burden, the refusal should be withdrawn because **IDVD** is suggestive and recognized by consumers as a source identifier.

As used in commerce, Applicant's **IDVD** mark is an inherently distinctive mark that, in its entirety, has no commonly recognized meaning, even though its separate parts may be recognizable terms. See *In re Geo. A. Hormel & Company*, 218 U.S.P.Q. 286, 287 (T.T.A.B. 1983) (refusal of registration reversed for **IN'EASY** mark for pre-cooked meats). Although

comprised of the elements “I” and “DVD,” the mark in its entirety³ is a unitary term **IDVD**, which is Applicant’s coinage as part of its family of registered “I”-formative marks, *i.e.*, **IBOOK** (Reg. No. 2,470,147), **ICHAT** (Reg. No. 2,090,641), **IMAC** (Reg. No. 2,763,155), **IMOVIE** (Reg. No. 2,735,051), and **ITUNES** (Reg. No. 2,653,465).

C. IDVD Is Inherently Distinctive For Apple’s Software Because It At Most Broadly Suggests The Nature Of Apple’s Goods And Associating It With The Goods Requires Imagination.

Apple’s mark is distinctive as applied to the goods and, at most, may be considered suggestive. As the Board in *In re Shutts*, 217 U.S.P.Q. 363, 364-365 (T.T.A.B. 1983), observed:

The concept of mere descriptiveness, it seems to us, must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and should not penalize coinage and hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and ‘mental pause.’

Apple’s evidence of consumer usage demonstrates that its coined **IDVD** mark is not recognizable in everyday language in connection with software goods such as those recited in the instant application. Because **IDVD** does not merely and directly describe the nature, character, function, or use of the goods with particularity, it is registrable. In a comparable case, *In re Aid Laboratories, Inc.*, the Board reversed refusal to register the mark **PEST PRUF** for animal shampoo with insecticide and deodorizing properties. The Board stated that the words “PEST PRUF” did not “describe applicant’s goods with any degree of particularity,” rather the terms

³ The rule is that even if the individual components of the mark may be ordinarily understood, —which Apple does not even concede to be the case here, especially in connection with the initial “I” component when used by Apple — the mark must be considered in its entirety. *See Rail-Trak Construction Co., Inc. v. Railtrack, Inc.*, 218 U.S.P.Q. 567 (T.T.A.B. 1983) (**RAIL-TRAK** not merely descriptive of railroad repair, inspection and maintenance services); *In re Waldorf Paper Products Co.*, 155 U.S.P.Q. 174 (T.T.A.B. 1967) (**STRIP-FLAP** not merely descriptive of an opening device sold as a component of paperboard cartons); *In re Warner*

Footnote continued on next page

were “merely suggestive of a possible end result of the use thereof.” See *In re Aid Laboratories*, 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983) (emphasis added). Here, Apple’s mark similarly does not describe the goods — basically, video and audio editing software — covered under the instant application with any degree of particularity. Instead, **IDVD** at most suggests one of many possible aspects of use of Apple’s goods and for that reason cannot be merely descriptive. *Id.*, cf. *In re Frank J. Curran Co.*, 189 U.S.P.Q. 560 (T.T.A.B. 1975) (**CLOTHES FRESH** not merely descriptive of clothes and shoe spray deodorant); *In re C.J. Webb, Inc.*, 182 U.S.P.Q. 63 (T.T.A.B. 1974) (**BRAKLEEN**, even if the phonetic equivalent of “brake clean,” does not merely describe a chemical composition for cleaning and degreasing automotive brake parts); and *In re Pennwalt Corporation*, 173 U.S.P.Q. 317 (T.T.A.B. 1972) (**DRI-FOOT** not merely descriptive of antiperspirant deodorant for feet).

Apple’s **IDVD** mark is also not merely descriptive because it requires considerable imagination to reach a conclusion as to the nature of Apple’s software goods from the term **IDVD**. This “imagination” requirement distinguishes a suggestive term from a descriptive one. T.M.E.P. § 1209(a). See *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983) (**SNO-RAKE** held not merely descriptive of a snow removal hand tool); *Airco, Inc. v. Air Products & Chemicals, Inc.*, 196 U.S.P.Q. 832 (T.T.A.B. 1977) (allowing registration of **AIR CARE** for services for maintenance of medical anesthesia and inhalation therapy equipment). When prospective purchasers see **IDVD**, more information than the mark itself is required to comprehend the nature of Apple’s software goods.

Footnote continued from previous page

Electric Brake & Clutch Company, 154 U.S.P.Q. 328, 329 (T.T.A.B. 1967) (**ELECTRO-MODULE** registrable for electromagnetic friction clutches and brakes).

Moreover, the fact that detailed analysis of Apple's mark could lead consumers to some understanding of the nature of Apple's goods does not mean that **IDVD** is merely descriptive. *See In re Nalco Chemical Company*, 228 U.S.P.Q. 972, 973 (T.T.A.B. 1986). In *In re Nalco*, the Board reversed the refusal to register the mark **VERI-CLEAN** in connection with goods for chemical anti-fouling. In the instant application, registration of the mark **IDVD** is sought for computer software. It is only after a multi-level analysis, a "mental pause," and full consideration of the attenuated evidence for each component term of Apple's mark, that the Examining Attorney has asserted a descriptive meaning. *See In re Shutts*, 217 U.S.P.Q. at 365. However, as in *Nalco*, even if the component terms in Apple's mark may be analyzed, understanding and interpreting the combination of the terms requires complex thought. For this reason also, Apple's mark is suggestive rather than merely descriptive. *See In re Nalco*, 228 U.S.P.Q. at 973.

Further, it is well established that a mark is not "merely descriptive" if it does more than describe the goods or service, their functions, characteristics, or applications. *See Application of Colonial Stores, Inc.*, 394 F.2d 549 (C.C.P.A. 1968). ("Sugar" and "Spice," although descriptive of ingredients in baked goods, held not merely descriptive when used together in **SUGAR & SPICE** mark for such goods). As in *Colonial Stores*, Apple's mark simply begins the suggestive process. Here, Apple does not sell "interactive DVDs." Rather as recited in the application, Apple sells computer software for use in creating, editing, authoring and/or playback of digital versatile disks.

It is not "immediate" that the **IDVD** mark describes the goods offered by Apple. The **IDVD** mark does not necessarily conjure up the image of software as a feature, characteristic, or function of Apple's mark and, therefore, is not merely descriptive.

D. The IDVD Mark Is As Suggestive As Other Third Party Registrations

The decisions of numerous Examining Attorneys to register marks conceptually and linguistically similar to **IDVD** for computer-related goods and services is convincing evidence that **IDVD** is not merely descriptive. It would be inconsistent and improper to deny registration of Apple's **IDVD** mark for software in light of the following marks, registered on the Principal Register without disclaimers or evidence of secondary meaning:

- **ITALK** for software that allows users to record sound and *speech*,
- **IVIDEO** for software that allows users to add panoramic imagery to *motion pictures*,
- **ISEND** for software for secure message and/or document *delivery*,
- **ISHIP** for software for preparing, processing, managing and tracking of *shipping* activities,
- **ICHARGE** for a battery *charging* system
- **ICOLOR** for electronic controllers that control the *color* and intensity of artificial light,
- **I-COUNT** for a *counting* workstation,
- **I/COLOR** for software for processing *colors* on digital images,
- **I-FORCE** for software for interfacing *force* feedback hardware, and
- **IHOLD** for hardware and software for delivering messages to telephone caller while placed on *hold*
- **ICORRECT** for software for color enhancement, color *correction* and color profiling of digital images
- **IMANAGE** for software for *managing* documents, audio, video, email, text, and other data

- **IEXPENSE** for accounting database management software for business planning, reporting and management
- **IPRIVACY** for hardware and software that enables users to protect their *privacy* while on the Internet
- **ITOUCH** for electronic *touch* sensors
- **IGRID** for software for assessing status of power *grids*
- **IPATCH** for telecommunications *patch* panels systems
- **ISCAN** for hand held bar code *scanner*
- **I-CUT** for digital cutting system
- **IQUOTE** for software for use in generating equipment rental *quotations*
- **IRENT** for software for use in equipment *rental*
- **IVIEW** for software to *view*, annotate, present and catalog digital text and media files

Apple offers evidence of these 22 and 10 other comparable registrations, a total of 32 registrations from the Office's database that make this point clearly. Bowen Decl., Exhibit A.

E. Any Doubt Should Be Resolved in Favor of Apple

For the reasons discussed above, it is neither "immediate" nor even readily understood that the **IDVD** mark describes Apple's software goods. Even if **IDVD** were not so clearly a suggestive mark, it is well recognized that where there is any doubt about whether the applicant's mark is merely descriptive as applied to the goods, "that doubt should be resolved in favor of the applicant." *See In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565, 565 (T.T.A.B. 1972) (refusal of registration reversed for **THE LONG ONE** mark as applied to bread). Here, Apple has clearly raised sufficient doubt about the mere descriptiveness of **IDVD** that the Examining Attorney should withdraw the refusal under Section 2(e) and allow registration of the mark.

**II. IN THE ALTERNATIVE, APPLE'S IDVD MARK HAS ACQUIRED
DISTINCTIVENESS**

It is permissible for an Applicant to argue the merits of an Examining Attorney's refusal and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness pursuant to Section 2(f) of the Trademark Act. The alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive. T.M.E.P. § 1212.02(c).

Thus, if the Examining Attorney maintains the refusal to register under Section 2(e), Apple requests, in the alternative, that the application be amended to include the following:

Registration is sought in accordance with § 2(f) of the Lanham Act. The mark has become distinctive in connection with the goods offered by Applicant in commerce.

Evidence of such distinctiveness is submitted herewith. *See* Declaration of Thomas R. La Perle ("La Perle Decl.") and Exhibits A-S thereto and Bowen Decl. and Exhibit A thereto.

A. Apple's Mark Is Entitled To Registration On The Principal Register

If not inherently distinctive, a mark may be registered on the Principal Register upon proof of acquired distinctiveness. As detailed below and in the evidence submitted herewith, Apple's widespread and extensively promoted use of **IDVD** has clearly caused consumers to recognize that term primarily as a source identifier for Apple's popular and successful software product. The development of secondary meaning in **IDVD** has been further hastened by Apple's use of **IDVD** as part of its well-known series of "I"-formative marks.

B. Evidence Showing The Extent And Nature Of Use Of The IDVD Mark Proves That The Mark Distinguishes Apple's Goods

As the evidence shows, through Apple's extensive use and promotion of the **IDVD** mark, **IDVD** functions to identify Apple as the source of its software goods. T.M.E.P. § 1212. Apple

submits that the following evidence is more than sufficient to establish a *prima facie* case of acquired distinctiveness. T.M.E.P. § 1212.01. The Examining Attorney must resolve any doubts as to the sufficiency of Apple's acquired distinctiveness evidence in Apple's favor. *See In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 4 USPQ2d 1141 (Fed. Cir. 1987). Here, Apple has clearly proven its **IDVD** mark is distinctive, but even if it has only raised some doubt on the question, the Examining Attorney should allow registration of the mark on the Principal Register under Section 2(f).

1. Apple's Group of "I"-Formative Trademarks

Apple has successfully introduced a series of computer hardware and software products under a group of "I"-formative marks. Apple has vigorously sought protection for, and enforced, its rights in its "I"-formative marks worldwide, including its **IDVD** mark. *See La Perle Decl.* ¶12, and Exhibits D & E thereto. Next to building a revolutionary product line, Apple's major contribution to the personal computer market has been its innovation in the creation of a branding strategy, comprising groups of thematically related marks, such as the various "MAC" marks and the well-known "I" marks - **IMAC®**, **IBOOK®**, **IMOVIE®**, **ITUNES®**, **ICHAT®**, **ICAL™**, **ILIFE™**, **IPOD™**, **IPHOTO™**, **ISIGHT™**, and **IDVD™**, among others. *Id.* ¶ 5.

Apple's extensive promotion of its well-known group of "I"-formative trademarks has predisposed the relevant consumers to recognize Apple's **IDVD** as a source identifier for the relevant goods.

2. Sales of Apple's Branded Products

Apple has been using the **IDVD** mark extensively in commerce in connection with software since January 9, 2001. The **IDVD** software is pre-installed on the **POWERMAC**, **POWERBOOK**, **IMAC**, and **IBOOK** computers ("Macintosh computers") that Apple sells.

Since the first quarter of 2001 when Apple introduced its **IDVD** software, over 8.6 million units of the Macintosh computers have been shipped. *Id.* ¶ 12. In fiscal year 2002 (which ended September 28, 2002), Apple sold over \$4.5 billion of Macintosh computers worldwide. In the first six months of 2003, Apple has already posted net sales of over \$2 billion worldwide for its Macintosh computers. *Id.* ¶ 6. The **IDVD** software is also promoted and sold as a component of Apple's **ILIFE**TM software, which also includes Apple's popular **IMOVIE**®, **ITUNES**® and **IPHOTO**TM software. Since the first quarter of 2003 when Apple introduced its **ILIFE** software, over 95,000 copies have been sold. *Id.* ¶ 12. The **IDVD** mark is prominently featured myriad times throughout the software in all of these products. *Id.* ¶¶ 8, 13, 14.

Apple's **IDVD** software is sold at over 60 proprietary Apple Store retail outlets, through a network of over 1,500 authorized resellers, and on the internet. Authorized resellers include CompUSA, Micro Center, Good Guys, Circuit City, Guitar Center, Amazon.com, Outpost.com, J&R Music World, Fry's Electronics. *Id.* ¶¶ 7, 8, 10.

The **IDVD** mark is prominently displayed in all the Apple Store retail outlets, as well as in select authorized reseller locations. *Id.* ¶ 8. In Apple's own stores, in-store audio-visual presentations feature the **IDVD** mark. *Id.* On the internet, Apple hosts a retail store at its *apple.com* web site. *Id.* ¶ 9, and Exhibit B & C thereto. The web page featuring the **IDVD** mark promoting the software has had over two million (2,000,000) page views since the product launched in January 2001 and almost one million (1,000,000) new visitors to the page since June 2002. Apple's customers continue to visit the web site to download updates to the **IDVD** software. More than approximately 250,000 visitors have viewed the **IDVD** software update download page since it was posted in January of 2002. *Id.*

3. Apple's Marketing Campaign For The IDVD Mark

Through extensive marketing efforts, Apple has been immensely successful in developing a loyal customer following and valuable brand identity for its various marks, including the **IDVD** mark. Apple has invested tremendous amounts of time, money, and effort in creating an association between the **IDVD** mark and Apple as the source of the **IDVD** software. Consumers recognize **IDVD** as a mark and use it to identify Apple as the source of the **IDVD** software. *Id.* ¶ 17.

a. Advertising

Over \$16 million (\$16,000,000) has been spent on promoting the **IDVD** mark alone. Apple's overall expenditures for advertising over the last four years for all products average \$240 million per year, meaning that Apple has invested a substantial portion of its sizable advertising budget on promoting the **IDVD** mark. *Id.* ¶ 18. Apple has advertised the **IDVD** mark in traditional forms of media, including network, spot, and cable television and print.

Apple has produced and widely broadcast two television ads for **IDVD**, investing approximately \$1.5 million to make the commercials and approximately \$10 million to purchase television air time nationwide in major market centers. *Id.* ¶19, and Exhibit J thereto. These commercials promoting the **IDVD** software have aired on cable and network television stations across the country. Networks stations include ABC, NBC, FOX, and WB; cable stations include Comedy Central, MTV, CNN, Headline News, and the Discovery Channel. Over 500 million (500,000,000) viewer impressions of the ad were made over the commercials' run. *Id.* ¶ 20.

Print publication with diverse content, and thus readership, have also been an important focus of Apple's advertising campaigns. Apple has spent over \$5 million in producing and placing advertisements for its **IDVD** software in major print publications targeted to consumers

and industry professionals. Print advertisements for the **IDVD** software have appeared in such well-known publications as *Time*, *Entertainment Weekly*, *Martha Stewart Living*, *Newsweek*, *Oprah*, *Rolling Stone*, *Self*, *Shape*, *Sports Illustrated*, *The New Yorker*, and *Yahoo!Internet Life*. *Id* ¶ 21 and Exhibit K thereto. These featured uses of the **IDVD** mark have exposed millions of consumers to the **IDVD** mark as an indicator of source for Apple's goods.

b. Public Relations

Apple's **IDVD** goods have been featured in many articles in national publications, including *Time*, *Fortune*, *PC Magazine*, *Forbes*, and *Business Week*, each clearly providing direct evidence that the primary meaning of **IDVD** for consumers is as a source indicator, not merely a descriptive reference. *Id* ¶ 23 and Exhibits M & N thereto. Hundreds of articles about Apple's **IDVD** product and trademark have been published since the product's launch in January of 2001. *See* Bowen Decl. ¶¶ 2, 3. Collectively, these non-paid promotions of the **IDVD** mark have resulted in hundreds of million impressions⁴ of the **IDVD** mark reaching consumers as an Apple trademark. *See* La Perle Decl. ¶ 23.

c. Promotional Activities

Apple distributes extensive printed collateral material in support of each new product. For example, a data sheet and FAQ describe the multiple features and benefits of the **IDVD** software. Printed promotional materials for the **IPOD**, **MAC OS X**, **IMAC**, **POWER MAC**, **IBOOK**, and **POWERBOOK** products also highlight the compatibility as well as the features of

⁴ An "impression" is the exposure of an individual or a household to the advertiser's message. The number of impressions accounts for "pass along readership." For example, a copy of a publication sitting in a doctor's waiting area is considered to make many more impressions than a copy mailed to a one-person household. Similarly, newspapers' impression figures reflect the number of businesses and households with two or more adults that receive the paper each day.

the **IDVD** software, all prominently using the **IDVD** mark to do so. *Id.* ¶ 25, and Exhibits I & O thereto.

d. Conferences and Trade Shows

Apple actively promotes its good and services, including its **IDVD** software, at a wide range of conferences and other promotional events. The Macworld Conference and Expo is a bi-annual conference that focuses entirely on Apple's goods and services and has prominently featured the **IDVD** software in recent years. The Macworld Conference and Expo draws large numbers of attendees: 93,000 people attended the conference in San Francisco in January 2001 when the **IDVD** software was introduced and featured in a stand-alone booth. An additional 250,000 people watched a live streaming presentation of the software's introduction over the internet. Later that year, the New York conference in July 2001 had over 64,000 attendees, as did the conference in San Francisco in January of 2002. Apple has prominently displayed the **IDVD** mark at these conferences and at other trade shows on signage and printed materials. In January of 2002, approximately 65,000 people attended, and more than 81,000 tuned into the live stream of Steve Jobs's Macworld keynote address at the Macworld Conference and Expo in San Francisco, during which the new generation **IMAC** computer was introduced to tremendous media reception. An entire section of the Apple exhibit was dedicated to the **IDVD** product, with prominent signage for **IDVD**. *Id.* ¶¶ 26-29, and Exhibits P-R thereto.

e. Direct Mail

Apple publishes and distributes subscriber-based email newsletters, *Apple eNews* and *iMac Update*, on a bi-weekly schedule to hundreds of thousands of interested readers. In its newsletters, Apple delivers news and information about Apple products, events, seminar opportunities, and promotional activities. In the case of **IDVD**, for example, the newsletters

offers tips, how-to articles, upgrade notices, and information about using **IDVD** software. *Id* ¶30 and Exhibit S thereto.

Through Apple's numerous and widespread activities to promote its goods, the **IDVD** mark has become distinctive of Apple's goods throughout the United States. Because the evidence of Apple's use of the **IDVD** mark showing that the mark has acquired distinctiveness is extensive, the **IDVD** mark is entitled to registration on the Principal Register under Section 2(f) of the Trademark Act.

III. CONCLUSION

Because **IDVD** is not merely descriptive, the refusal to register the **IDVD** mark cannot be maintained. It should be withdrawn and registration allowed. In the alternative, Applicant has more than amply stated a *prima facie* case of acquired distinctiveness and registration on the Principal Register should be allowed under Section 2(f) of the Trademark Act. Applicant believes that the application is now fully in condition for passage to publication and prompt action to that end is earnestly solicited. If a telephone conversation would be appropriate to further the prosecution of this application, please contact the undersigned.

Respectfully submitted,

APPLE COMPUTER, INC.

Dated: November 19, 2003

By: Thomas R. La Perle
Thomas R. La Perle, Esq.
Intellectual Property Counsel

Apple Computer, Inc.
1 Infinite Loop, MS: 3 TM
Cupertino, California 95014
Tel: 408-974-2385
Fax: 408-253-0186
60083624 v1



EXHIBITS

Proceeding/Serial No: 75 865010

Filed: _____

Title: _____



BULKY EXHIBITS

Proceeding/Serial No: 75 865080

Filed: _____

Title: _____



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COPY

TRADEMARK
Attorney Docket No. 20750-15US

Date of Deposit: November 19, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3514.

By: 

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:

APPLE COMPUTER, INC.¹

Serial No. 75/865,080

Filed: December 16, 1999

Mark: **IDVD**

NOTICE OF APPEAL

Commissioner for Trademarks
Box TTAB FEE
2900 Crystal Drive
Arlington, VA 22202-3514

Madam:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examining Attorney dated May 19, 2003 finally refusing registration of the above-identified mark. Applicant has timely filed a Request for Reconsideration with Examining Attorney Michele-Lyn Swain (Law Office 116).

¹ By assignment from Ravisent IP, Inc., record by the Assignment Division on November 18, 2003, Reel 002748, Frame 0775.

Please direct all correspondence in this appeal to:

Thomas R. La Perle, Esq.
Intellectual Property Counsel
Apple Computer, Inc.
1 Infinite Loop, MS: 3 TM
Cupertino, California 95014
Tel: 408-974-2385
Fax: 408-253-0186

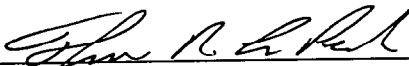
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Please charge the fee of \$100.00 to the Deposit Account of Apple Computer, Inc., No. 01-2150. Please charge any additional fees that may be due, or credit any overpayment, to our Deposit Account No. 01-2150. Two copies of this Notice are enclosed.

Respectfully submitted,

APPLE COMPUTER, INC.

Dated: November 19, 2003

By: 
Thomas R. La Perle, Esq.
Intellectual Property Counsel

Apple Computer, Inc.
1 Infinite Loop, MS: 3 TM
Cupertino, California 95014
Tel: 408-974-2385
Fax: 408-253-0186

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